

Applicants provisionally elect with traverse to prosecute the claims of Group I, claims 1-5 and 7-19 drawn to a purified nucleic acid. It is noted that Applicants reserve the right to prosecute the subject matter of any non-elected claim in a related copending application.

Remarks

As above Applicants have provisionally elected with traverse to prosecute the claims of Group I. It is respectfully requested that the Examiner reconsider this restriction in order that Applicants might be allowed compact and expedited prosecution of the present application.

Restriction can be required by the Office for certain reasons as set forth in the MPEP under section 800. Such restriction is entirely at the discretion of the Office. Restriction is required so that an undue burden is not placed on the Office in prosecuting the application, so that the statutory fee structure is not subverted, and so that the integrity of the examination and classification system of the Office are not jeopardized. Requirement for restriction is balanced against the right of the Applicants to claim their invention as they require to adequately protect their invention and to provide for compact and expedited prosecution.

Applicants respectfully submit that the presently claimed invention relates to compositions and methods which together comprise a single inventive concept. Under 35 U.S.C. § 121, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) the inventions must be independent or distinct as claimed; and
- (2) there must be a serious burden on the examiner if restriction is not required. See MPEP § 803. Applicants submit that the first of these criteria is not met by the presently claimed invention which generally relates to compositions comprising nucleic acid sequences that encode Rm3, the amino acid sequence of the encoded Rm3 and methods for using either the nucleic acid sequences or amino acid sequences of Rm3. Because Applicants believe these compositions and methods represent a single inventive concept, the claims properly encompass a single patentable invention.

Second, Applicants believe that because the present claims comprise a single inventive concept, any search of the patent or scientific literature directed to such compositions and methods would be expected to encompass art in the field of the invention as claimed.

Indeed, by performing a search relating to the claims of Group I, the search would also reveal art relevant to the claims of Groups II through VI, and *visa versa*. Thus, prosecution of the invention, as a whole, would not place a burden on the Examiner sufficient to justify restriction.

Further, one instance where the Office has not always required restriction is in an art where patents have been allowed to issue with claims to a distinct nucleic acid sequence and related methods for uses of those sequences. Applicants note that in the general art of nucleic acid sequences encoding polypeptides or proteins, patents have issued directed to the nucleic acid sequence and to related methods for the use of the claimed nucleic acid sequence in expression of the encoded polypeptide, the nucleic acid sequence in transformed host cells, and the like. Therefore, Applicants respectfully request that the Examiner reconsider this request for restriction in light of office practices common to the art. In particular, Applicants request that the claims of Groups I and III be combined for prosecution on the merits.

CONCLUSION

In view of the foregoing, Applicants have elected with traverse Group 1, claims 1-5 and 7-19. Reconsideration of the request for restriction is respectfully requested for the reasons set forth above. Applicants believe all claims now pending in this application, are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If for any reason the Examiner believes that a telephone conference would expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at 206-467-9600.

Respectfully submitted,

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